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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/536,485

05/24/2005

Giovanni Meazza

163-626

6851

47888 7590 03/05/2008  
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EXAMINER

MURRAY, JEFFREY H

ART UNIT

PAPER NUMBER

1624

MAIL DATE

DELIVERY MODE

03/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/536,485	<b>Applicant(s)</b> MEAZZA ET AL.	
	<b>Examiner</b> JEFFREY H. MURRAY	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 4-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 25-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/24/2005</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This action is in response to a restriction election filed on January 8, 2008. There are twenty-eight claims pending and seven claims under consideration. Claims 4-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 8, 2008. The applicants have elected Group I with traverse. This is the first action on the merits. This invention relates to new uracils having a high herbicidal activity, the processes for their preparation and methods for their use as herbicides for controlling weeds in agricultural crops.

2. Applicant's election with traverse of Group I in the reply filed on January 8, 2008 is acknowledged. The traversal is on the ground(s) that there is a technical relationship between the separately grouped claims. This is not found persuasive because the examiner has determined that there are several different process groups which are not related. For example, one process involves a cyclo-condensation reaction, whereas another process involves a halogen displacement reaction. Yet another process involves an alkylation reaction. All of these processes would involve completely different searches. Each group's processes are performed independently of each other and could support separate patents. The processes differ in reagents, starting materials and final products. One skilled in the art would not consider such diverse processes as functional equivalents of each other. The mere fact that there is a single similarity is not

in itself a significant reason to render the whole embodiment obvious. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

### ***Priority***

3. Acknowledgment is made of Applicant's claim for domestic priority. This application, U.S. Application No. 10/536,485, filed on May 24, 2005, is a national stage application of PCT/EP03/14469, filed on December 15, 2003, claims foreign priority to Italian Application No. MI2002A002758, filed December 23, 2002.

### ***Specification***

4. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

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- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A “Sequence Listing” is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required “Sequence Listing” is not submitted as an electronic document on compact disc).

5. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any of the errors of which applicant may become aware of in the specification.

#### ***Claim Objections***

6. Claim 1 is objected to because of the following informalities: Lines 4 and 5 separate out the X1 and X2 variables with a number, whereas the rest of the claim separates out the variables with a dash. To eliminate confusion, it is suggested to convert the “3” and “4” to dashes as well. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-3 and 25-28 are rejected because the claims cover “uracils” and “compositions” whereby the claims are improper in their number. According to 35 U.S.C. 101, an applicant may obtain “a patent.” Therefore the claims must be directed to a ***single invention***, not a plurality of inventions. Examiner suggests to applicant to

change the claims to read, "A uracil..." or "The composition...". No new matter permitted. Appropriate correction is required.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup>***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 25 recites the limitation: "...possibly also as a blend of isomers." The grammar here is indefinite. Examiner does not understand the last several words of this claim as the term "possibly" leaves the entire claim indefinite. In addition, applicant gives no information as to what isomers or what kind of "blend". Examiner suggests removing this phrase from the claim to make it more comprehensible. Appropriate correction is required.

11. Regarding claim 26, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Appropriate correction is necessary.

12. Claim 27 recites the limitation: "...*the further herbicides* are selected from:..." The grammar here is indefinite. In referring back to independent claim 25, from which claim 27 depends, there is no mention of a "herbicide." Claim 25 claims a composition containing a compound or compounds of claim 1 and does not state that any

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“herbicides” are added in addition to the compound. Appropriate correction is necessary.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-3 and 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Wanger, et. al., U.S. Patent No. 4,859,229. The current application recites a uracil of Formula (I) whereby R can be alkyl, X<sub>4</sub> can be a haloalkyl group, G=O, X<sub>1</sub> and X<sub>2</sub> may represent a halogen, and X<sub>3</sub> may represent a ether group. The prior art represents a uracil whereby its R<sub>1</sub> can be alkyl, R<sub>5</sub> may be a haloalkyl group, R<sub>3</sub> and R<sub>4</sub> may represent a halogen, and R<sub>2</sub> may represent an ether group.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

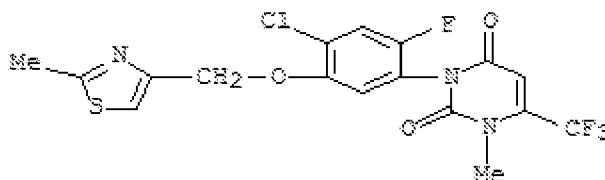
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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claims 1-3 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wenger, et. al., (EP Patent No. 0255047) in view of *In re Norris* (CCPA

1950) 179 F2d 970, 84 USPQ 458. The current application relates to new uracils having a high herbicidal activity, the processes for their preparation and methods for their use as herbicides for controlling weeds in agricultural crops.

Wenger et. al. teaches a number of uracil compounds including compound Registry No. 114170-30-8; 3-[4-chloro-2-fluoro-5-[(2-methyl-4-thiazolyl)methoxy]-phenyl]-1-methyl-6-(trifluoromethyl)- 2,4(1H,3H)-pyrimidinedione.



The compound listed above falls under claim 1 of the current application except for one distinct difference. The compound of Wenger, et. al. contains a thiazol-4-yl group in the position where the "Q" would be located for the current application. The current application lists that Q may be a "thiazol-2-yl" or "thiazol-5-yl" group. The compounds in the current application have a use as herbicidal compounds, which is the same use that the compounds of Wenger et. al. possess.

Compounds having the same radical at different positions on the nucleus are position isomers. Their properties are often so nearly alike as to present difficulties in



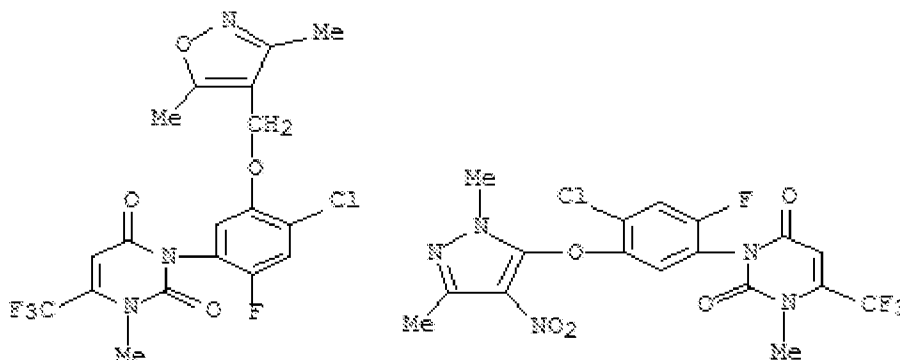
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identification or separation. *Ex parte Mowry* (POBA 1950) 91 USPQ 219. A novel, useful compound which is isomeric with a compound of the prior art is unpatentable unless it possesses some unobvious or unexpected beneficial property not possessed by the prior art compound. *In re Norris* (CCPA 1950) 179 F2d 970, 84 USPQ 458; *In re Finley* (CCPA 1949) 174 F2d 130 and 135, 81 USPQ 383 and 387.

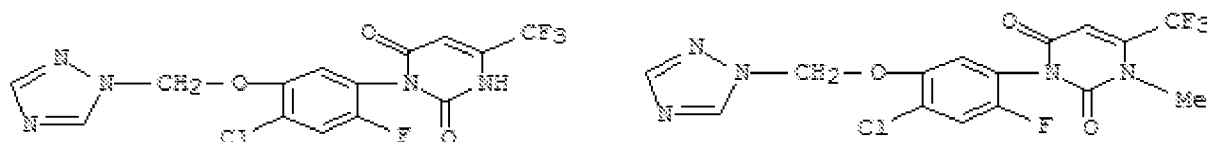
It would have been obvious to one skilled in the arts at the time of the invention to be motivated to combine Wenger, et. al. and the case law of *In re Norris* to synthesize either the compound, 3-[4-chloro-2-fluoro-5-[(2-methyl-2-thiazolyl)methoxy]-phenyl]-1-methyl-6-(trifluoromethyl)- 2,4(1H,3H)-pyrimidinedione or 3-[4-chloro-2-fluoro-5-[(2-methyl-5-thiazolyl)methoxy]-phenyl]-1-methyl-6-(trifluoromethyl)- 2,4(1H,3H)-pyrimidinedione for use as a herbicidal compound.

Wenger, et. al. combined with *In re Norris* shows the necessary teachings that suggest shifting the heterocyclic thiazolyl ring attachment from the 4-position to the 2- or 5-position in an attempt to enhance activity and afford a positive benefit from the replacement.

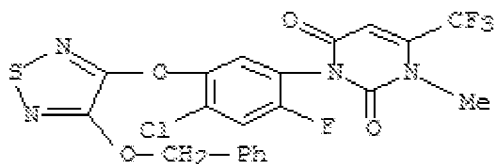
Examiner would like to inform applicants that this same argument also applies to Registry No. 114170-26-2 and 114170-02-4 of the same Wenger document:



It also applies to Registry No. 313046-22-9 and 313046-23-0 of CN 1327984 and Jacobsen, et. al., US 6258751:



and Registry No. 353293-58-0 of EP1122244:



### ***Double Patenting***

18. Applicant is advised that should claim 1 be found allowable, claim 3 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Conclusion***

19. Claims 1-3 and 25-28 are rejected.
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is (571) 272-9023. The examiner can normally be reached on Mon-Thurs. 7:30-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a US PTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey H Murray/  
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